

### **REMARKS**

Claims 1-6 are all the claims pending in the application. Claims 1, 2 and 6 are being examined. Claim 2 is linking claim as defined in MPEP § 809.03. Rejoinder of process claims 3-5 is requested upon allowance of claims 1 and 6 and/or linking claim 2.

The specification is amended to delete the subject matter added in the Amendment filed January 16, 2009 relating to the JIS Z 0237 standard. Claims 1 and 2 are amended to delete the reference to JIS Z 0237. No new matter is presented.

#### **I. The Objections and Rejections**

The Examiner indicates that the Amendment filed on January 16, 2009 is objected to under 35 U.S.C. § 132(a) because it introduces new matter into the disclosure. The Examiner states that the attempt to incorporate subject matter into the specification by reference to JIS Z 0237 is ineffective.

The Examiner also indicates that the drawing submitted with the specification amendment are objected to because of Fig. 7, which is included in the specification and must be provided on a separate sheet.

Claims 1-2 and 6 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite with respect to the “in terms of ball tack obtained by the ball rolling method provided for in JIS Z 0237”.

#### **II. Applicants Response**

First, Applicants note that the JIS Z 0237 and the partial English translation thereof was inadvertently omitted during E-filing due to clerical error. The JIS Z 0237 standard and partial English translation thereof are submitted herewith to complete the record.

Without conceding the merits of the objections to the specification and the drawings, the specification is amended herein to delete the JIS Z 0237 standard added in the Amendment filed January 16, 2009, thereby obviating the objection to the specification and the objection to the drawings.

Without conceding the merits of the rejection under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, Claims 1 and 2 are amended herein to delete the reference to the ball rolling method provided for in JIS Z 0237.

Applicants further submit that the present claims are definite and the scope of the claims can be readily ascertained when properly read in light of the specification as previously pointed out. Specifically, the Examiner's focus in determining whether the claims are definite in compliance with 35 U.S.C. § 112, second paragraph should be whether the claims set out the claimed subject matter with a reasonable degree of clarity and particularity in light of (1) the content of the specification; (2) the teachings of the prior art; and (3) the claim interpretation that would be given by one of ordinary skill in the art.

The primary purpose of the requirement for definiteness of claim language is to ensure that the scope of the claims is clear. A second purpose is to provide a clear measure of what Applicants regard as their invention so that it can be determined whether the claimed invention meets all the criteria of patentability. See MPEP § 2173.

The present claims recite that the thermosetting sheet has a tackiness of 2-15 in terms of ball tack. Ball tack is defined in the specification as being obtained by the ball rolling method provided for in JIS Z 0237. One of ordinary skill in the art is familiar with the JIS standard mentioned in the present specification. The JIS standard is readily available and provides a clear measure for determining ball tack.

Thus, Applicants submit that the present claims are definite and one of ordinary skill in the art would readily be able to determine the meaning and scope of the claims in view of the present claims, the description in the specification as filed, and the knowledge and teachings in the prior art. In this connection, the specification as filed specifically states: “*The term "ball tack" in the invention means values obtained by the ball rolling method as provided for in JIS Z 0237*” at page 6, lines 21-23. This statement indicates that the term “ball tack” is defined by values obtained by the ball rolling method described in JIS Z 0237. Even further, in each of the working examples in the present specification, the tackiness of the thermosetting sheet material is measured in terms of “ball tack”, which as described at page 6, lines 21-23, is the value obtained by the ball rolling method of JIS Z 0237. Applicants also submit a copy of the JIS Z 0237 standard (latest revision in 2000)<sup>1</sup> and a sworn partial English translation thereof.

The specification as filed provides the standard for determining the ball tack and provides examples wherein the tackiness of the thermosetting sheet material is measured in terms of “ball tack”, which is a term of art readily understood by those skilled in the art.

For the reasons set forth above, the claims are definite and one of ordinary skill in the art would be able to readily ascertain the meaning and scope of the claimed invention.

Accordingly, Applicants respectfully request withdrawal of the §112, 2<sup>nd</sup> paragraph, rejection.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

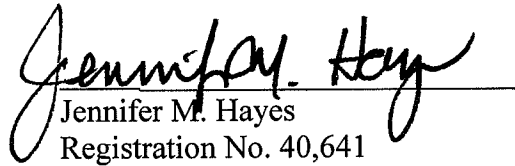
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<sup>1</sup> Applicants note that the designation “Z 0237:2000” on the front page of the Standard indicates the latest revision in the year 2000.

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
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